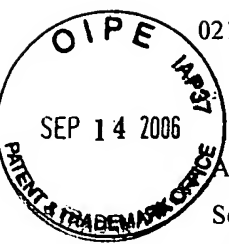


22W
AP



0212.67070

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John B. Freese
Serial No.: 10/615,726
Conf. No.: 1792
Filed: 7/9/2003
For: HYBRID ROUTER
Art Unit: 3725
Examiner: Self, Shelley M.

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

9/14/06
Date Registration No. *26179*
Attorney for Applicant(s)

TRANSMITTAL OF APPEAL BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on July 11, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00

(complete (a) or (b) as applicable)

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

Extension fee for response within first month:
() By a small entity (1.9(f)) \$ 60.00
() By other than a small entity \$ 120.00

Extension fee for response within second month:
() By a small entity (1.9(f)) \$ 225.00
() By other than a small entity \$ 450.00

Extension fee for response within third month:
() By a small entity (1.9(f)) \$ 510.00
() By other than a small entity \$ 1020.00

Extension fee for response within fourth month:
() By a small entity (1.9(f)) \$ 795.00
() By other than a small entity \$ 1590.00

() The extension fee has already been filed in this application.

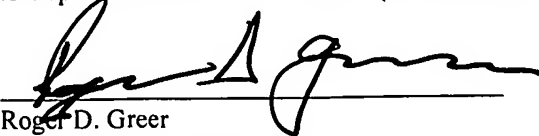
() A check in the amount of \$ _____ for the extension of time fee is enclosed.

() (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

() A check in the amount of \$_____ is enclosed for filing the Appeal Brief.

(X) The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Dated: September 11, 2006


Roger D. Greer
Registration No. 26,174

Address to which Correspondence is to be sent:

GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive, 25th Floor
Chicago, Illinois 60606
(312) 360-0080



0212.67070

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John B. Freese
Serial No.: 10/615,726
Conf. No.: 1792
Filed: 7/9/2003
For: HYBRID ROUTER
Art Unit: 3725
Examiner: Self, Shelley M.

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

9/11/06
Date

[Signature]
Registration No. 26474
Attorney for Applicant(s)

09/14/2006 HLE333 00000061 10615726

01 FC:1402

500.00 DP

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

This Appeal Brief is in support of Applicant's Notice of Appeal dated July 11, 2006.

REAL PARTY IN INTEREST	1
RELATED APPEALS AND INTERFERENCES	1
STATUS OF CLAIMS	1
STATUS OF AMENDMENTS AFTER FINAL.....	1
SUMMARY OF CLAIMED SUBJECT MATTER.....	1
GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	3
ARGUMENT.....	3
Claims 32 and 44 are Improperly Rejected Based Upon the Combination of Tomayko and Long.....	4
Claim 46 is Improperly Rejected Based Upon the Combination of Pientka and Long	9
CONCLUSION	9
CLAIMS - APPENDIX	A-1
EVIDENCE - APPENDIX	A-5
RELATED PROCEEDINGS - APPENDIX	A-6

REAL PARTY IN INTEREST

Credo Technology Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims that are pending, finally rejected and appealed are 32-37 and 44-48, of which claims 34-37 have been objected to. Claims 1-22 and 38-43 have been allowed. Claims 23-31 stand withdrawn.

STATUS OF AMENDMENTS AFTER FINAL

No amendments have been made after final.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally concerns power hand tools, specifically routers.

More particularly, the independent claims, which are claims 32, 44 and 46 are annotated with references to the specification and drawings, as follows:

32. A router comprising:

a motor assembly (30; Figs. 1-5; Pg 3/1-2) having a housing (36; Figs. 1-7; Pg 6/5-9) containing a motor (37; Figs. 1-2; Amendment A, Pg 2/4) for driving an output shaft (52; Figs. 1, 3; Pg 6/13-15) to which a bit holding mechanism (54; Fig 1; Pg 6/13-15) can be attached, operating handles (44, 46; Figs. 1-7; Pg.6/5-9) attached to said housing for use by an operator, and operating controls (56, 58, 59; Figs. 1-5; Pg 6/15-21) for operating said motor; and,

a fixed base assembly (34; Figs 3-4, 19-24; Pg 6/3-4, 7/3-17) into which said motor assembly can be removably installed, said fixed base assembly having a planar bottom surface (88; Figs 3, 4; Pg 8/6), a depth adjustment mechanism (48, 92, 94; Figs. 3-4, 19-24; Pg 8/3-9/6) and a motor assembly locking mechanism (90; Figs. 19-24; Pg 8/8-17, 17/17-18/6) for locking said motor assembly in said fixed base assembly.

44. A router comprising:

a motor assembly (30; Figs. 1-5; Pg 3/1-2) having a housing (36; Figs. 1-7; Pg 6/5-9) containing a motor (37; Figs. 1-2; Amendment A, Pg 2/4) for driving an output shaft (52; Figs. 1, 3; Pg 6/13-15) to which a bit holding mechanism (54; Fig 1; Pg 6/13-15) can be attached, operating handles (44, 46; Figs. 1-7; Pg.6/5-9) attached to said housing for use by an operator, and operating controls (56, 58, 59; Figs. 1-5; Pg 6/15-21) for operating said motor; and,

a fixed base assembly (34; Figs 3-4, 19-24; Pg 6/3-4, 7/3-17) into which said motor assembly can be removably installed, said fixed base assembly having a planar bottom surface (88; Figs 3, 4; Pg 8/6), a depth adjustment mechanism (48, 92, 94; Figs. 3-4, 19-24; Pg 8/3-9/6) and a first motor assembly locking mechanism (90; Figs. 19-24; Pg 8/8-17, 17/17-18/6) for removably locking said motor assembly in said fixed base assembly.

46. A router motor assembly (30; Figs. 1-5; Pg 3/1-2) that is capable of being removably installed in a fixed base and operate as a fixed base router or is capable of being removably installed in a plunge base and operate as a plunge router, said motor assembly comprising a housing (36; Figs. 1-7; Pg 6/5-9) with a motor (37; Figs. 1-2; Amendment A, Pg 2/4) for driving an output shaft (52; Figs. 1, 3; Pg 6/13-15) to which a bit holding mechanism (54; Fig 1; Pg 6/13-15) can be attached for holding a tool bit, operating handles (44, 46; Figs. 1-7; Pg.6/5-9) attached to said housing for use by an operator, and operating controls (56, 58, 59; Figs. 1-5; Pg 6/15-21) for operating said motor.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether the §103(a) rejection of claims 32 and 44 should be reversed as being an improper rejection based upon the combination of the Tomayko and Long references.

Whether the §103(a) rejection of claim 46 should be reversed as being an improper rejection based upon the combination of the Pientka and Long references.

ARGUMENT

Claims 32 and 44 are Improperly Rejected Based Upon the Combination of Tomayko and Long

The examiner has rejected claims 32 and 44 under 35 U.S.C. 103(a) as being unpatentable over Tomayko in view of Long.

Applicant continues to believe that claim 32 and 44 should be allowed. The examiner contends that Tomayko meets the elements of these claims, but admits that Tomayko does not disclose the handles to be attached to the motor housing. Instead, the examiner contends that “it would be obvious at the time of the invention to one of ordinary skill in the art to rearrange Tomayko such that the handles were attached to the motor housing *because rearranging parts of an invention involves only routine skill in the art*, citing *In re Japikse*, 86 USPQ 70. (CCPA 1950)”

The examiner’s reliance on this decision is legally flawed. *In re Japikse*, 86 USPQ 70, which is a 1950 CCPA decision does not even begin to correctly state the law of obviousness that has evolved in the last 55 years, particularly since the establishment of the Court of Appeals for the Federal Circuit. *In re Japikse*, is not found to have ever been cited by a federal district court in a patent case or in the Court of

Appeals for the Federal Circuit in any appeal, and the examiner's reliance upon this case is totally misplaced.

In fact, in subsequent decisions, the Board of Patent Applications and Interferences, has criticized the decision. For example, in *Ex Parte Boris E. Makutonin, Frank G. Oliverio And Matthew J. Zdinak*, (unpublished) the Board stated: In the present case, the examiner fails to advance any factual basis to supply the admitted deficiencies of Scarpa vis-a-vis the subject matter recited in independent claims 1, 16, 24, 35 and 36. Instead, the examiner attempts to bridge Scarpa's evidentiary gaps by resort to so-called mechanical or per se rules of obviousness allegedly established by the *St. Regis* and *Japikse* cases. Such rules do not exist, however, and the reliance thereon by the examiner to establish obviousness under section 103(a) is improper. See *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

Also in *Ex Parte Stuardo A. Robles, Thanh Pham And Bang C. Nguyen*, (unpublished) the board stated: "The examiner cites *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the general proposition that "a mere shifting the location of parts" of an apparatus is a matter of obviousness for the skilled artisan (page 4 of Answer). However, our review of the case reveals no such proposition or rule of law."

A more accurate statement of the law of obviousness is set forth in relevant Federal Circuit decisions:

Each prior art reference must be viewed in its entirety and the Court cannot ignore portions that argue against obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986), citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). As this court has stated, virtually all [inventions] are combinations of old elements. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 875, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 159-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (Most, if not all, inventions are combinations and mostly of old elements.). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). *In re Denis Rouffet, Yannick Tanguy and Frederic Berthault*, (Fed. Cir. 1998).

It is recognized by those skilled in the art of routers that there are important differences between plunge routers and fixed base routers, as well as hybrid routers which have a common motor unit that can be inserted into a fixed base as well as a plunge router base. The present application is directed to a hybrid router. If a Google or similar search on hybrid or combination routers is performed, it is clearly evident that there are many manufacturers in the tool business that sell such hybrid routers. No hybrid router products have been located by such a search conducted by the undersigned which have handles attached to anything other than the plunge base and fixed base part of the combination. Stated in other words, none of the hybrid routers that have been located have ever had a removable motor assembly where the operating handles are attached to the motor assembly housing.

It simply has not been done and given the fact that routers have been around for decades, the examiner's simplistic conclusory assertion that it would have been obvious to rearrange Tomayko such that the handles were attached to the motor housing certainly rings hollow and cannot be reconciled with the history of development of such tools through the decades.

When Tomayko is carefully examined, it is not known how it would be modified to put the handles on the motor unit. Since the motor unit of Tomayko screws into the fixed base, there are many design implications that would be raised. This is confirmed by the many design considerations that are described in the present application.

Equally if not more importantly, there is no suggestion or motivation in Tomayko to make such a modification. Nor does Long supply the deficiencies of Tomayko either. Moreover, Long is a plunge router rather than a fixed base router and it does not have a motor assembly that can be removed from such a fixed base assembly, nor is it capable of being removed from a plunge base assembly. It is just a conventional plunge router that has very little relevance to the invention claimed in claim 32.

For the examiner to state that Long's plunge router teaches or suggests the elements of claim 32 mischaracterizes of the teachings of the Long patent. The fact that Long states that the handles of the present invention can also be used on a fixed base style router is believed to be irrelevant to the general teachings of Long. It is clear that Long emphasizes the nuances of the shape of his handles, as shown and described in terms of the dimensions Z, L, R and D as well as the angle α (see FIGS 2 and 5). This special and well defined configuration provides the context for the examiner's citation that "The handles of the present invention can also be used on a fixed base style router". What that means is that handles of that same shape could be used with a fixed base router. There is no disclosure whatsoever that these handles are attached to a motor assembly that can be removably installed in either a fixed base assembly or a plunge base assembly. To contend otherwise is a mischaracterization and gross distortion of the Long patent.

The comments that have been made with regard to Tomayko and Long with regard to claim 32 equally apply to claim 44.

Claim 46 is Improperly Rejected Based Upon the Combination of Pientka and Long

With regard to claim 46 which has been rejected under 35 U.S.C. 103(a) as being unpatentable over Pientka in view of Long, this rejection should also be reversed. Claim 46 claims a motor assembly that is capable of being removably installed in a fixed base and operate as a fixed base router or is capable of being removably installed in a plunge base and operate as a plunge router, with the motor assembly comprising a housing as recited as well as operating handles attached to the housing. Pientka simply does not teach or suggest this construction, nor do any of the other patents of record.

The examiner also again misrepresents the teachings of Long and it is clear that the handles of Pientka are not attached to a motor assembly, but are attached to its base 12. This claim is also not taught or suggested by any of the references of record, applied alone or in combination with one another.

CONCLUSION

The dependent objected to claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and also should be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to allowance.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By


Roger D. Greer

Registration No. 26,174

September 11, 2006

300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978

CLAIMS - APPENDIX

32. A router comprising:

a motor assembly having a housing containing a motor for driving an output shaft to which a bit holding mechanism can be attached, operating handles attached to said housing for use by an operator, and operating controls for operating said motor; and,

a fixed base assembly into which said motor assembly can be removably installed, said fixed base assembly having a planar bottom surface, a depth adjustment mechanism and a motor assembly locking mechanism for locking said motor assembly in said fixed base assembly.

33. A router as defined in claim 32 wherein said motor assembly further comprises a depth adjustment controller that controls the depth of cut of a bit when said motor assembly is installed in said fixed base assembly, wherein said depth adjustment controller comprises a knob that is located on the top of one side of the motor assembly housing, rotation of the knob causing the depth of cut to be increased or decreased depending upon the direction of rotation.

34. A router as defined in claim 32 wherein said fixed base assembly comprises a formed base portion having a vertical central opening in which a major portion of said motor assembly housing can be inserted, the outer configuration of the major portion of said motor assembly that is inserted generally conforming to the configuration of the inner surface of the formed base portion such that the motor assembly can be vertically moved therein during installation and removal and to adjust

the depth of cut of an installed bit, said formed base portion having at least one segment of relatively thin wall around the circumference thereof, said motor assembly locking mechanism comprising:

an elongated live hinge in said one relatively thin wall segment, said hinge having one end integral with said wall and an unattached opposite free end;

a clamp lever operably attached to the outside of said formed base portion and pivotable between locking and unlocking positions, said clamp lever having a cam surface for engaging the free end portion of said hinge, said cam surface moving said free end portion inwardly to press against said motor assembly housing for securely holding the same when said clamp lever is pivoted into said locking position.

35. A router as defined in claim 34 wherein said live hinge is formed by an absence of wall material along the periphery of said hinge, said hinge being generally horizontally oriented and having one end integral with said wall, with the length of said hinge including its opposite end being unconnected to said wall.

36. A router as defined in claim 35 further comprising a set screw inserted in a threaded aperture located in said free end portion of said hinge, said set screw being rotatably adjustable to vary the amount of inward movement of said free end portion that occurs when the lever is pivoted into said locking position.

37. A router as defined in claim 34 wherein said major portion of said motor assembly housing that is inserted into said fixed base assembly has an outer configuration that varies sufficiently throughout its vertical dimension that would produce a deviation of the output shaft from perpendicular to said planar bottom surface,

said major portion of said motor assembly housing having at least one vertical recess in the outer configuration opposite the side that is contacted by said live hinge, said recess extending from the bottom upwardly therefrom, said recess having a flat bottom that is parallel to said output shaft, said fixed base assembly having an inwardly protruding vertically oriented rail with a top surface that is perpendicular to said fixed base planar bottom surface, said rail top surface engaging said recess flat bottom when said first locking mechanism clamp lever is pivoted into said locking position, thereby assuring that said output shaft is perpendicular to said fixed base planar bottom surface.

44. A router comprising:

a motor assembly having a housing containing a motor for driving an output shaft to which a bit holding mechanism can be attached, operating handles attached to said housing for use by an operator, and operating controls for operating said motor; and,

a fixed base assembly into which said motor assembly can be removably installed, said fixed base assembly having a planar bottom surface, a depth adjustment mechanism and a first motor assembly locking mechanism for removably locking said motor assembly in said fixed base assembly.

45. A router as defined in claim 44 wherein said motor assembly further comprises a depth adjustment controller that controls the depth of cut of a bit when said motor assembly is installed in said fixed base assembly, wherein said depth adjustment controller comprises a knob that is located on the top of one side of the motor assembly

housing, rotation of the knob causing the depth of cut to be increased or decreased depending upon the direction of rotation.

46. A router motor assembly that is capable of being removably installed in a fixed base and operate as a fixed base router or is capable of being removably installed in a plunge base and operate as a plunge router, said motor assembly comprising a housing with a motor for driving an output shaft to which a bit holding mechanism can be attached for holding a tool bit, operating handles attached to said housing for use by an operator, and operating controls for operating said motor.

47. A router motor assembly as defined in claim 46 further comprising a depth adjustment controller that controls the depth of cut of the tool bit when said motor assembly is installed in either said fixed base or plunge base, wherein said depth adjustment controller comprises a knob that is located on the top of one side of the motor assembly housing, rotation of the knob causing the depth of cut to be increased or decreased depending upon the direction of rotation.

48. A router motor assembly as defined in claim 46 wherein said operating handles comprise a pair of handles, each of which has a generally horizontal shoulder portion which extends from an opposite side of said housing and which merge with a generally vertical grip portion that extends downwardly from the shoulder portion, the bottom end of said grip portions extending to an elevation that can approach the elevation of said bottom of the base in which said router motor assembly is installed to thereby provide added stability during operation.

EVIDENCE - APPENDIX

None.

RELATED PROCEEDINGS- APPENDIX

None.